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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Thomaston Mills, Inc.**

Serial Nos. 75/419,344, 75/419,512 and 75/419,915

William L. Feeney of Miles & Stockbridge for applicant.

Nicholas K. D. Altree, Trademark Examining Attorney, Law
Office 109 (Ronald R. Sussman, Managing Attorney).

Before Quinn, Chapman and Wendel, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

Applications have been filed by Thomaston Mills, Inc.
to register the marks THOMASTON MILLS BED-IN-A-BAG,
THOMASTON BED-IN-A-BAG, and THOMASTON MILLS BED IN A BAG
("BED-IN-A-BAG" or "BED IN A BAG" disclaimed) for "bed
sheets, pillowcases, bed ruffles, pillow shams and
comforters."¹

¹ Application Serial Nos. 75/419,344, 75/419,512 and 75/419,515,
respectively, filed January 16, 1998, alleging a bona fide
intention to use the mark in commerce.

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The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act on the ground of likelihood of confusion with the following four previously issued registrations, all owned by the same registrant:

for "bedding, namely, comforters, bed skirts, pillowshams, sheets and pillowcases;"² BED-IN-A-BAG for "bedding, namely, comforters, bed skirts, shams, sheets and pillowcases;"³

for "bedding products, namely, comforters, bed skirts,

² Registration No. 1,964,833, issued April 2, 1996 on the Principal Register. The words "Bed In A Bag," "Sheet Set," "Comforter," "Bed Skirt" and "Pillowsham(s)" are disclaimed apart from the mark.

³ Registration No. 2,003,752, issued September 24, 1996 on the Supplemental Register.

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shams, sheets and pillowcases;"⁴ and BED IN A BAG for "bedding products, namely, sheets, pillowcases, comforters, pillow shams and bedskirts, not actual beds."⁵

When the refusals were made final, applicant appealed. Applicant and the Examining Attorney filed briefs. An oral hearing was not requested. Because of the essentially identical issues involved in these appeals, the Board shall decide them in one opinion.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

In the present case, there is no dispute regarding the similarity between registrant's and applicant's goods. Indeed, the goods are legally identical.

⁴ Registration No. 2,021,550, issued December 10, 1996 on the Principal Register. The words "Bed In A Bag" are disclaimed apart from the mark. The stippling is a feature of the mark and is not intended to indicate color.

⁵ Registration No. 2,113,088, issued November 11, 1997 on the Supplemental Register.

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The issue of likelihood of confusion clearly turns, therefore, on a comparison of the involved marks. In view of the treatment of the words "Bed In A Bag" in all of the cited registrations (that is, the words are the subject of either a Supplemental Register registration or a disclaimer), the words would appear to be highly descriptive of the goods involved in this appeal. Because of the highly descriptive nature of the words "Bed In A Bag" (or "Bed-In-A-Bag"), we do not believe that applicant's mark, which includes applicant's trade name, so resembles any of the cited marks as to be likely, even when the marks are used in connection with the same goods, to cause confusion.

We must compare the marks in their entirety, including the addition of the trade name in applicant's mark. The presence of a trade name or a house mark may or may not eliminate a likelihood of confusion between the entire marks of the parties. See: 3 J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition*, §23:43 (4th ed. 2000). In the instant ex parte case, the presence of "THOMASTON MILLS" or "THOMASTON" in applicant's marks alleviates the likelihood of confusion with registrant's marks. We find the case of *In re S. D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984), to be applicable to the present case.

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In that case, the Board stated the following (at pp. 55-56):

Although it has often been said that the addition of a trade name, house mark, or surname to one of two otherwise confusingly similar marks will not generally serve to avoid a likelihood of confusion between them, exceptions to this general rule are made (1) when there are recognizable differences between the assertedly conflicting product marks, or (2) when the alleged product marks are highly suggestive or merely descriptive or play upon commonly used or registered terms. [citations omitted]

See also: In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); Rockwood Chocolate Co. v. Hoffman Candy Co., 372 F.2d 552, 152 USPQ 599 (CCPA 1967); and In re Merchandising Motivation, Inc., 184 USPQ 364 (TTAB 1974).

In our opinion, the present case falls within the second category of exceptions to the general rule. Two of the cited registrations issued on the Supplemental Register and, in the other two Principal Register registrations (as well as in the involved application), the words "Bed In A Bag" were disclaimed. This treatment of the words clearly shows the highly descriptive nature thereof when applied to bedding products. Accordingly, we conclude that the addition of the trade name "THOMASTON MILLS" or "THOMASTON"

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to "BED IN A BAG" (or "BED-IN-A-BAG") in applicant's marks is sufficient to avoid likelihood of confusion. Although we note the Examining Attorney's attempt to distinguish the S. D. Fabrics case, *supra*, from the present one, we share applicant's view that the situations are quite similar, and that the prior case portends the same result here.

Decision: The refusals to register in all three applications are reversed.

T. J. Quinn

B. A. Chapman

H. R. Wendel
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

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